memory-mapped. The Examiner further asserts that "From the instant disclosure it would appear that such a data base would be stored in ROM which does not appear likely." In response, Applicants respectfully traverse the Examiner's assertions. First of all, the disclosure does not state that the database would be stored in ROM. This is apparently a belief of the Examiner caused by the Examiner's reliance upon column 8, lines 17-31 in U.S. Patent No. 5,301,302 cited by the Examiner whereby it is stated that BIOS is read from ROM into a shared memory segment. However, the present invention differs in that a read-only file stored on a hard disk 101 (see Figure 1) is converted into an executable code for memory-mapping. Therefore, Applicants do not believe that the Abstract needs to be modified.

II. REJECTION UNDER 35 U.S.C. § 102

The Examiner has rejected Claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by *Blackard, et al.* (U.S. Patent No. 5,301,302). In response, Applicants respectfully traverse this rejection.

As the Examiner is well aware, for a claim to be anticipated, each and every element of the claim must be found within the single prior art reference. Claim 1 specifically recites that a read-only file is converted into an executable file. This is not performed by *Blackard.* The Examiner supports his rejection by referring to column 8, line 21, *et seq.* in *Blackard.* However, *Blackard* discloses therein that a simulator 10 copies BIOS 13 from ROM 15 into the operating system's shared memory segment 16. The BIOS 13 is then used to load the DOS for which the application was originally written. The simulator then translates and executes that operating system. This does not disclose the conversion of a read-only file into an executable file. Merely, BIOS is copied from ROM into the shared memory segment 16.

Furthermore, the Examiner then asserts that the memory-mapping step of Claim 1 is taught in *Blackard* in column 16, line 21, *et seq.* This portion of *Blackard* refers to translating the addresses of a first processing system into the addresses of a second processing system. Column 16, lines 16-17. To do this, the memory of the first processing system is mapped into the memory of the second processing system. Column 16, lines 18-20. This portion of *Blackard* is not referring to the BIOS copied from ROM into the shared memory segment 16, as is disclosed in column 8, lines 21, *et seq.* Therefore, *Blackard* does not teach that the BIOS copied from ROM is then memory-mapped. The Examiner is taking two separate and unrelated teachings within *Blackard* and combining them to assert that *Blackard* anticipates Claim 1. This is not permissible. To anticipate, the elements taught in the prior art must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *see also* MPEP § 2131. Consequently, the case law does not support the Examiner's rejection, because the Examiner's citation of the language in column 8 and the language in column 16 in *Blackard* does not result in as complete detail as is contained within the claim.

Claims 7 and 13 are also not anticipated for the same reasons as given above with respect to Claim 1.

Claim 4 specifically recites that the converted file appears to the operating system loader as a shared library file. The Examiner asserts that the "shared memory is taught by the reference as the shared memory segments taught on column 16, line 21." Applicants respectfully traverse this assertion by the Examiner. First of all, the Examiner is referring to a "shared memory", while the claim specifically recites a "shared library file", which is not the same as a shared memory. Therefore, the Examiner has failed to prove a *prima*

facie case of anticipation in rejecting Claim 4. Furthermore, the shared memory segments discussed in column 16 of *Blackard* merely refer to a memory that is used to store an image of the memory of another system, which is not the same as a shared library file. A library file is a collection of routines used by a processing system, and a shared library file is a collection of routines that can be used within a processing system by several applications. MICROSOFT PRESS COMPUTER DICTIONARY, p. 209, copyright 1991 by Microsoft Press. Therefore, Claim 4 is not anticipated by *Blackard.*

With respect to Claim 5, the Examiner asserts that the read-only file being a database file is inherent in the teaching of the reference in that the data in the read-only file may be formatted as a database. Applicants respectfully traverse this assertion. The Examiner has already asserted that the read-only file is the BIOS 13 copied from ROM. BIOS is not a database file. For this reason alone, the Examiner has failed to prove that *Blackard* teaches that the read-only file converted into the executable file is a database file.

Furthermore, the Examiner's assertion that the recitation in Claim 5 is inherently taught in *Blackard* is an incorrect interpretation of the law. It is stated in MPEP § 2131 that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. vs. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In that case, it was asserted by one party that a prior art patent process did not anticipate an invention, because the heel did not function as a heat sink. However, the Court asserted that the property of the heel was to still function as a heat sink even though it was not identified specifically as a "heat sink" within the patent. Thus, when the case law refers to a prior art reference inherently teaching an element, it is referring to an element having the same properties as the device asserted to be anticipated by the prior art reference. That is not the case with the present application, and

specifically Claim 5. The Examiner is asserting that the read-only file being a database file is inherent in the teaching of the reference in that the data in the read-only file may be formatted as a database. However, the Examiner has failed to point to any portion of *Blackard* that teaches that a read-only file may be formatted as a database, and more specifically, nowhere in *Blackard* has the Examiner pointed to that the BIOS copied from ROM may be a database file. Therefore, *Blackard* does not expressly or inherently teach that a read-only file to be converted into an executable file may be a database file.

Claim 6 specifically recites that the converting step further comprises the step of wrapping the read-only file with executable code. The Examiner has failed to point to an express teaching in *Blackard* of this limitation. Instead, the Examiner has asserted that this limitation is inherent in *Blackard* in its discussion of instruction address translation in column 13, line 22, *et seq.* Applicants respectfully disagree. The instruction address translation discussed in *Blackard* does not teach the wrapping of anything with executable code. Instead, *Blackard* merely teaches that a new instruction pointer 31 and code segment 33 whose values are determined at runtime are converted into the simulator machine address of the corresponding translation for those instructions that transfer control dynamically. There is nothing within this portion of *Blackard*, or anywhere else within *Blackard*, that discusses or teaches the wrapping of a read-only file with executable code. Nothing within *Blackard* teaches either expressly or inherently an ability or property for wrapping a file with executable code. Therefore, Claim 6 is not anticipated by *Blackard.*

Claims 8-12 and 14-18 are also patentable over *Blackard* in view of the foregoing remarks.

Claims 19 and 20 recite respectively that the read-only file is an image file and an audio file. Again, the Examiner has failed to point to any express teaching in *Blackard* whereby a read-only file is either an image file or an audio file. Instead, the Examiner

merely asserts that "the type of data and type of file is inherent in the teaching of the reference and the data could be either image or audio." Applicants respectfully traverse this assertion by the Examiner because it is the Examiner's own opinion without any type of support whatsoever within *Blackard*. In asserting that this is inherent in the teaching of *Blackard* the Examiner has even failed to refer to any specific language within *Blackard*. If the Examiner asserts that there is an inherent teaching in the reference, the Examiner must still point to such a teaching. Applicants respectfully assert that the Examiner must specifically point to language within *Blackard* that either expressly or inherently teaches these limitations, or the Examiner's assertion of anticipation must fail.

Moreover, Applicants again refer to the Examiner's rejection of Claims 1, 7 and 13, whereby the Examiner refers to the language recited in column 8, line 21, *et seq.* in *Blackard* for teaching these claim limitations. The Examiner has asserted that the BIOS copied from ROM teaches the read-only file converted into an executable file. If this were to be true, then the Examiner's rejection of Claims 19 and 20 cannot stand, because it is quite clear that a BIOS cannot be an image file or an audio file.

As a result of the foregoing, Applicants respectfully assert that the claims are allowable over *Blackard*.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,
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